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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/814,557

03/31/2004

Diane Bihary

7432

28/078 7590 06/16/2009
MAGINOT, MOORE & BECK, LLP
CHASE TOWER
111 MONUMENT CIRCLE
SUITE 3250
INDIANAPOLIS, IN 46204

EXAMINER

SCHAPIER, MICHAEL T

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

06/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,557

Applicant(s)

BIHARY ET AL.

Examiner

MICHAEL T. SCHAPER

Art Unit

3775

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 20-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 20-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

However, in terms of similarly rejected claims by the Examiner, Examiner notes that Applicant's arguments filed 10-17-07 have been fully considered but they are not persuasive. See below:

As to Applicant's arguments that amended claim 1 is patentable over the prior art, Examiner notes that the amended phrase **"configured to sealingly engage the inner surface of an acetabular liner"** is a purely functional statement. See MPEP § 2114.

As to Applicant's arguments that amended claim 25 is patentable over the prior art, Examiner notes that the amended phrase **"configured to abut a 360 degree portion of the inner surface of an acetabular liner"** is a purely functional statement. See MPEP § 2114.

As to Applicant's arguments for claim 3 that Baumann does not disclose a head with two o-rings, please see new rejection as per the amendment.

As to Applicant's arguments to claims 5-7, Examiner notes that the prior art as seen in *Skow* discloses a second valve in the bulb syringe to be connected to the reservoir of IV fluid which, pending combination of the two references, would

analogously be connected to the reservoir of air with respect to the main reference of *Wendt*.

As to Applicant's arguments that claim 20 has not been properly rejected over obviousness, Examiner notes that Applicant has assumed that the manner of insertion using *Wendt* would comprise of collapsing on the liner using the arms of the wrench mechanism. Examiner asserts that the conduit 20 of *Wendt* would structurally suffice, with respect to the claimed invention, to properly insert an acetabular liner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 8, 11, 25-27 and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by *Wendt* (US Patent Number 5,896,886).

Wendt discloses a handheld instrument for, *i.e.* capable of, insertion of an acetabular liner into an acetabular cup comprising: a shaft, e.g. 25, having an internal channel, e.g. 11, therethrough and a first and a second end portion, a bulb syringe, e.g. 35, sealingly engaged with the first end portion of the shaft and a head portion (see figure 2), which is capable of sealingly engaging the inner surface of an acetabular liner, having a curvilinear outer perimeter and an internal chamber (see figure 2), a first o-ring/first groove, e.g. 21 (see figure 3 and column 3, lines 2-8) circumscribing the

curvilinear outer perimeter of the head and a valve/stop check valve, e.g. 26 (see figures 1-3).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Wendt, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Moreover, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendt (US Patent Number 5,896,886) in view of Baumann (US Patent Number 3,723,995).

Wendt discloses the claimed invention except a second o-ring/groove/channel. Baumann discloses two o-rings/grooves/channels, e.g. 5 and 6, in an acetabular head, e.g. 1+3, and liner, e.g. 2, combination for proper sealing engagement (see figure and column 1, lines 52-55) of the two leak paths in Baumann, analogous to the instant application. It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Wendt with a second o-ring/groove/channel, in view of Baumann, for proper sealing engagement of the two leak paths in Baumann, analogous to the instant application.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendt (US Patent Number 5,896,886) in view of Skow (US Patent Number 6,620,132).

Wendt discloses the claimed invention except for an additional valve.

Skow discloses a bulb syringe 2 valve system and teaches the second valve "to prevent liquid from exiting the valve until a predetermined amount of pressure is provided by bulb actuation" (see figure 19 and claim 1).

It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Wendt with an additional valve, in view of Skow, to prevent liquid from exiting the valve until a predetermined amount of pressure is provided by bulb actuation.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendt (US Patent Number 5,896,886).

Wendt discloses the claimed invention except the shaft having a bend of between about 20 and about 45 degrees and about 30 degrees.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Wendt with the shaft having a bend of between about 20 and about 45 degrees or about 30 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendt (US Patent Number 5,896,886) in view of Sweeney (US Patent Publication Number 2005/0015059).

Wendt discloses the claimed invention except a kit having a plurality of heads.

Sweeney discloses a kit having a plurality of inserts to allow the surgeon "to select an appropriate insert based on the particular needs of the patient" (see paragraph 0039).

It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Wendt as a kit having a plurality of heads, in view of Sweeney, to allow the surgeon to select an appropriate insert based on the particular needs of the patient.

Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendt (US Patent Number 5,896,886) in view of Sweeney (US Patent Publication Number 2005/0015059).

Wendt discloses the claimed invention except heads fit with liners having diameters of 26mm, 28mm, 32mm, 36mm or 38mm.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Wendt with heads fit with liners having diameters of 26mm, 28mm, 32mm, 36mm or 38mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL T. SCHAPER whose telephone number is (571)270-7413. The examiner can normally be reached on M-F, 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on (571)272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. T. S./
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775

